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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,669	02/21/2002	Joyce Phillips	CITI0244	4814

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KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

NGUYEN, NGA B

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/078,669

Applicant(s)

PHILLIPS, JOYCE

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 22-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the Election Response filed on January 3, 2007, which paper has been placed of record in the file.
2. Claims 1-21 and 31-36 are elected for consideration.

Response to Arguments/Amendment

3. Applicant's election without traverse of Group I (claims 1-21 and 31-36) in the reply filed on January 3, 2007 is acknowledged.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 31 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox et al (hereinafter Fox), U.S. Patent No. 5,943,624.

Regarding to claim 31, Fox disclose a system for electronic commerce comprising:

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a transaction card associated with a consumer, wherein said transaction card exchanges data with a receiving terminal (figure 1 and column 2, lines 10-30, the cellular telephone 10 electronically communicates with an external system);

a contact-less integrated circuit within said transaction card (column 15-20, the RF interface provides a contactless interface between the smartcard logic function circuitry in telephone 10 and an external reader/system); and

an antenna associated with said transaction card (figure 1 and column 2, lines 30-37, antenna 18);

wherein said receiving terminal wirelessly reads data from said transaction card (column 5, lines 5-35, the RF card reader associated with a banking institution of a point-of-sale system reads the data from the smartcard within the cellular telephone 10).

Regarding to claim 33, Fox further discloses wherein said receiving terminal is a point-of-sale terminal (column 5, lines 10-12).

Regarding to claim 34, Fox further discloses wherein said antenna is embedded within a body of said transaction card (figure 1 and column 2, lines 30-37, antenna 18).

Regarding to claim 35, Fox further discloses an inductive loop of low frequency electronic magnetic radiation to provide power to said transaction card (figure 2 and column 4, lines 3-8, battery and power conditioner 54).

6. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Kawan, U.S. Patent No. 6,442,532.

Regarding to claim 21, Kawan discloses a system for electronic commerce comprising:

means for storing data on a transaction card (column 4, lines 20-30, storing data in read-write memory on the smart card);

means for exchanging data between a communication device and said transaction card (figure 2C and column 4, lines 7-15, the cellular telephone 75 includes a smartcard reader 84 for exchanging data between the cellular telephone with the smartcard);

means for transmitting data wirelessly from said communication device (column 4, lines 47-60);

means for making purchases of goods/services with said communication device (column 8, lines 25-30); and

means for debiting an account associated with said transaction card for said purchases (column 8, lines 30-35).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al (hereinafter Fox), U.S. Patent No. 5,943,624, in view of Treyz et al (hereinafter Treyz), U.S. Patent No. 6,587,835.

Regarding to claim 32, Fox does not disclose wherein said receiving terminal is a vending machine. However, Treyz discloses wherein said receiving terminal is a vending machine (column 10, lines 20-25). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Fox's to include the feature taught by Treyz above for the purpose of providing more convenient to the customer when buying products or services at vending machine.

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al (hereinafter Fox), U.S. Patent No. 5,943,624, in view of Natsuno, U.S. Patent No. 6,910,624.

Regarding to claim 36, Fox does not disclose wherein said receiving terminal communicates with a payment center gateway to determine whether an account of said consumer is sufficient to carry out a transaction associated with said receiving terminal. However, Natsuno discloses wherein said receiving terminal communicates with a payment center gateway to determine whether an account of said consumer is sufficient to carry out a transaction associated with said receiving terminal (column 15, lines 40-55, merchant server transmits the credit card contract information and sales amount information to the credit company's server, the credit company server retrieves the credit information in the member database and determines if the credit limit is not exceeded). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Fox's to incorporate the feature taught by Natsuno above for the purpose of verifying credit card information in order to decide to approve or reject the transaction.

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10. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (hereinafter Treyz), U.S. Patent No. 6,587,835.

Regarding to claim 1, Treyz discloses a system for electronic commerce comprising:

a wireless communication device (column 9, lines 55-65, handheld computing device 12);

a transaction card reader connected to said communication device (column 18, lines 18-20, handheld computing device 12 includes smartcard attachment or smartcard circuitry);

wherein said transaction card is used to purchase goods/services over a communications network (column 18, lines 20-55).

Treyz does not disclose a first entity wherein said first entity provides a consumer said communication device and wherein a second entity supplies said first entity a transaction card for use in said transaction card reader, said transaction card subsequently provided to said consumer. However, a first entity wherein said first entity provides a consumer said communication device and wherein a second entity supplies said first entity a transaction card for use in said transaction card reader, said transaction card subsequently provided to said consumer. For example, the first entity is mobile phone service provider (e.g. Verizon, AT&T, Cingular, T-Mobile, etc...) provides mobile phones and service contracts to their customers, the second entity is the bank or credit card company (e.g. Bank of America, Capital One, Chase, etc...) provides debit or credit cards to their customers. Therefore, it would have been obvious to one with

ordinary skill in the art at the time the invention was made to modify Treyz's to incorporate the well-known features for the purpose of providing more convenient to the customer to purchase products or services using the mobile phone.

Regarding to claims 2-3, Treyz does not disclose where said first entity is a mobile telephone service provider and said second entity is a financial institution. However, where said first entity is a mobile telephone service provider and said second entity is a financial institution are well known in the art. For example, the first entity is mobile phone service provider (e.g. Verizon, AT&T, Cingular, T-Mobile, etc...) provides mobile phones and service contracts to their customers, the second entity is the bank or credit card company (e.g. Bank of America, Capital One, Chase, etc...) provides debit or credit cards to their customers. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Treyz's to incorporate the well-known features for the purpose of providing more convenient to the customer to purchase products or services using the mobile phone.

Regarding to claim 4, Treyz further discloses wherein said communications network is the Internet (column 48, lines 22-35).

Regarding to claim 5, Treyz further discloses wherein said transaction card is a smart card (column 18, lines 18-20).

Regarding to claim 6, Treyz further discloses wherein said communication device is a mobile telephone (column 9, lines 55-65).

Claims 7-12 contain similar limitations found in claims 1-6 above, therefore, are rejected by the same rationale.

Regarding to claims 13-15, Treyz does not disclose wherein said transaction card stores bundled financial products, wherein said bundled financial products are provided under a single brand name, wherein said bundled financial products are accessed through a proprietary merchant network. However, wherein said transaction card stores bundled financial products, wherein said bundled financial products are provided under a single brand name, wherein said bundled financial products are accessed through a proprietary merchant network are well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Treyz's to incorporate the well-known features for the purpose of providing more convenient to the customer to purchase products or services using the transaction card stores bundled financial products.

Regarding to claim 16, Treyz further discloses an Internet browser associated with said communication device (column 48, lines 22-35).

Regarding to claims 17-20, Treyz does not disclose wherein said transaction card comprises data of at least one multiple payment brand for use in an open network, wherein said transaction card is associated with a loyalty program for redemption of goods/services, wherein said transaction card comprises data regarding a first account associated with a first currency and a second account associated with a second currency, a second transaction card, wherein said second transaction card is supplied by said first entity and said second transaction card is associated with an alternative payment brand. However, such transaction card are well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention

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was made to modify Treyz's to incorporate the well-known features for the purpose of providing more convenient to the customer to purchase products or services using the transaction card.

Conclusion

11. Claims **1-21** and **31-36** are rejected.

12. The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Sarradin (US 6,847,816) discloses a mobile phone is equipped with a smartcard reader to aid in universal payment by smart card.

Ausems et al. (US 6,434,403) disclose a wireless telephone engine, smartcard engine and PDA engine are integrated in a single device.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571) 272-6777.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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C/o Technology Center 3600

Washington, DC 20231

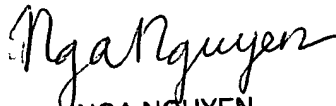
Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

April 11, 2007